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EXAMINER

BAUGH, APRIL L

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 12/26/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,600

Applicant(s)

TOYODA, KIYOSHI

Examiner

April L Baugh

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-- Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4&7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group I claims 1-12 and 14-25 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the search fields are significantly overlapping if not substantially identical and that there is no serious burden on the examiner. This is not found persuasive because invention I (claims 1-12 and 14-25) is distinct from invention II (claims 13 and 26) because they are subcombinations disclosed as usable together in a single combination but separately usable as well. Although both inventions are classified under 709/249 the keyword search required for invention I (apparatus and method for transmitting image data) is not required for invention II's search (apparatus and method for receiving image data) because they are distinct and function differently and therefore the search would be a burden for the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Specification

2. The disclosure is objected to because of the following informalities: pg. 1, line 11 'TPC/IP' should be 'TCP/IP' and on pg.1, line 24 'IAX' should be 'IFAX'.

Appropriate correction is required.

3. Claim 17 objected to because of the following informalities: p.36 claim 17, lines 11 'directly' should be 'indirectly'. Appropriate correction is required.

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Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Fig.2, reference 6, Fig. 4, reference 21 and 44, Fig. 6, reference 601, Fig. 7, reference 720, Fig. 8, reference ST804 and ST815, Fig. 11, reference ST1104 and ST1105, and Fig. 14, reference ST1402. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim1-4, 6-12, 14-17, and 19-25 rejected under 35 U.S.C. 102(b) as being unpatentable by US Patent No. 5,812,278 to Toyoda et al.

Regarding claim 1, Toyoda et al. teaches an image transmitting apparatus for transmitting image data to an image receiving apparatus (column 1, lines 29-31) to which an IP address is assigned from an outer section (column1, lines 35-37), the image transmitting apparatus comprising: a memory for storing a physical address of the image receiving apparatus (column 10, lines 64-65); a processor adapted to obtain the IP address of the image receiving apparatus by use of the physical address stored in the memory (column 11, lines 29-30); and a transmitter for

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directly transmitting image data to the image receiving apparatus by use of the IP address (column 11, lines 6-11).

Referring to claim 2, Toyoda et al. teaches the apparatus according to claim 1, wherein the memory store the physical address to be associated with a destination mail address (column 1, lines 45-46).

Regarding claim 3, Toyoda et al. teaches the apparatus according to claim 2, further comprising: an inputter for inputting the destination mail address (column 10, lines 66-67); and a searcher for searching the physical address corresponding to the destination mail address input by the inputter, wherein the processor obtains the IP address of the image receiving apparatus by use of the physical address searched by the searcher (column 7, lines 39-42).

Referring to claim 4, Toyoda et al. teaches the apparatus according to claim 3, wherein the transmitter directly transmits image data to the image receiving apparatus by use of the IP address, and indirectly transmits image data to the image receiving apparatus via a mail server (column 10, lines 48-52).

Referring to claim 6, Toyoda et al. teaches the apparatus according to claim 4, further comprising a controller (column 11, lines 6-11 of Toyoda et al.) for determining whether image data is directly transmitted to the image receiving apparatus by the transmitter on the basis of the destination mail address or indirectly transmitted to the image receiving apparatus via the mail server (column 10, lines 48-52 of Toyoda et al.).

Regarding claim 7, Toyoda et al. teaches the apparatus according to claim 4, further comprising: a table for storing the destination mail address and transmission type information to be associated with each other (column 2, lines 28-31); and a controller for determining whether

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image data is directly transmitted to the image receiving apparatus by the transmitter on the basis of the transmission type corresponding to the destination mail address or indirectly transmitted to the image receiving apparatus via the mail server when there is the destination mail address input by the inputter in the table (column 10, lines 48-52 and column 11, lines 6-11).

Referring to claim 8, Toyoda et al. teaches the apparatus according to claim 7, wherein the inputter includes a one-touch button (column 15, lines 29-30), and the table is a one-touch button registering table for storing the number of the one-touch button, the destination mail address, and the transmission type to be associated with one another (column 2, lines 28-31).

Regarding claim 9, Toyoda et al. teaches the apparatus according to claim 8, further comprising a register for registering the number of the one-touch button and the destination mail address in the one-touch button registering table so as to request an operator to specify the transmission type at the time of registration (column 6, lines 58-61).

Referring to claim 10, Toyoda et al. teaches the apparatus according to claim 7, wherein the table is an abbreviated dial registering table for storing an abbreviated dial, the destination mail address, and the transmission type to be associated with one another (column 7, lines 42-45 and column 15, lines 29-30).

Regarding claim 11, Toyoda et al. teaches the apparatus according to claim 10, further comprising a register for registering the abbreviated dial and the destination mail address in the abbreviated dial registering table so as to request an operator to specify the transmission type at the time of registration (column 6, lines 58-61 and column 15, lines 29-30).

Referring to claim 12, Toyoda et al. teaches the apparatus according to claim 1, further comprising a register for receiving notification of the physical address of the image receiving

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apparatus, and for registering the physical address included in the notification in the memory (column 1, lines 45-46 and column 2, lines 28-31 and column 6, lines 58-61).

Regarding claim 14, Toyoda et al. teaches an image transmitting method for transmitting image data to an image receiving apparatus (column 1, lines 29-31) to which an IP address is assigned from an outer section (column 1, lines 35-37), the method comprising storing a physical address of the image receiving apparatus (column 10, lines 64-65); obtaining the IP address of the image receiving apparatus by use of the stored physical address (column 11, lines 29-30); and directly transmitting image data to the image receiving apparatus by use of the IP address (column 11, lines 6-11).

Referring to claim 15, Toyoda et al. teaches the method according to claim 14, wherein the physical address is stored to be associated with a destination mail address in the step of storing the physical address (column 1, lines 45-46).

Regarding claim 16, Toyoda et al. teaches the method according to claim 15, further comprising inputting the destination mail address (column 10, lines 66-67); and searching the physical address corresponding to the input destination mail address, wherein the IP address of the image receiving apparatus is obtained by use of the searched physical address in the step of obtaining the IP address (column 7, lines 39-42).

Referring to claim 17, Toyoda et al. teaches the method according to claim 16, further comprising the step of directly transmitting image data to the image receiving apparatus via a mail server (column 10, lines 50-52).

Referring to claim 19, Toyoda et al. teaches the method according to claim 17, further comprising the step of determining whether image data is directly transmitted to the image

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receiving apparatus on the basis of the destination mail address or indirectly transmitted to the image receiving apparatus via the mail server (column 10, lines 48-52 and column 11, lines 6-11).

Regarding claim 20, Toyoda et al. teaches the method according to claim 17, further comprising the step of, when there is the input destination mail address in a table for storing the destination mail address and transmission type information to be associated with each other (column 2, lines 28-31), determining whether image data is directly transmitted to the image receiving apparatus on the basis of the transmission type corresponding to the destination mail address or indirectly transmitted to the image receiving apparatus via the mail server (column 10, lines 48-52 and column 11, lines 6-11).

Referring to claim 21, Toyoda et al. teaches the method according to claim 20, wherein the table is a one-touch button (column 15, lines 29-30) registering table for storing the number of the one-touch button, the destination mail address and the transmission type to be associated with one another (column 2, lines 28-31).

Regarding claim 22, Toyoda et al. teaches the method according to claim 21, further comprising the step of registering the number of the one-touch button and the destination mail address in the one-touch button registering table so as to request an operator to specify the transmission type at the time of registration (column 6, lines 58-61).

Referring to claim 23, Toyoda et al. teaches the method according to claim 20, wherein the table is an abbreviated dial registering table for storing an abbreviated dial, the destination mail address, and the transmission type to be associated with one another (column 7, lines 42-45 and column 15, lines 29-30).

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Regarding claim 24, Toyoda et al. teaches the method according to claim 23, further comprising the step of registering the abbreviated dial and the destination mail address in the abbreviated dial registering table so as to request an operator to specify the transmission type at the time of registration (column 6, lines 58-61 and column 15, lines 29-30).

Referring to claim 25, Toyoda et al. teaches the method according to claim 14, further comprising the step of receiving notification of the physical address of the image receiving apparatus, wherein the physical address included in the notification is stored in the step of storing the physical address (column 1, lines 45-46 and column 2, lines 28-31 and column 6, lines 58-61).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,812,278 to Toyoda et al. in view of Mori.

Regarding claim 5, Toyoda et al. teaches the apparatus according to claim 4, further comprising a controller (column 11, lines 6-11 of Toyoda et al.) for causing the transmitter to directly transmit image data to the image receiving apparatus by use of the IP address or for causing the transmitter to indirectly transmit image data to the image receiving apparatus via the mail server (column 10, lines 48-52 of Toyoda et al.).

Toyoda et al. does not teach detecting whether or not a specific mark is added to the destination mail address. Mori teaches detecting whether or not a specific mark is added to the destination mail address input by the inputter (column 9, lines 1-15 and column 24, lines 6-9, 51, and 58-59 of Mori). Therefore it would have been obvious to one having ordinary skill in the art at the time that the invention was made to further modify the image communicating method, facsimile type electronic mail apparatus and facsimile apparatus of Toyoda et al. by detecting whether or not a specific mark is added to the destination mail address because this is an efficient way to determine how to transmit the image data.

Regarding claim 18, Toyoda et al. teaches the method according to claim 17, wherein an image data is directly transmitted to the image receiving apparatus by use of the IP address or the image data is indirectly transmitted to the image receiving apparatus via the mail server (column 10, lines 48-52 and column 11, lines 6-11 of Toyoda et al.).

Toyoda et al. does not teach detected whether or not a specific mark is added to the input destination mail address. Mori teaches detected whether or not a specific mark is added to the input destination mail address (column 9, lines 1-15 and column 24, lines 6-9, 51, and 58-59 of Mori). Therefore it would have been obvious to one having ordinary skill in the art at the time that the invention was made to further modify the image communicating method, facsimile type electronic mail apparatus and facsimile apparatus of Toyoda et al. by detecting whether or not a specific mark is added to the input destination mail address because this is an efficient way to determine how to transmit the image data.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April L Baugh whose telephone number is 703-305-5317. The examiner can normally be reached on Monday-Friday 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 703-308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-9149 for regular communications and 703-746-9149 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

ALB
December 23, 2002



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